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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,860	11/28/2001	**Ronald D. Blum**	027001-000310US	9812

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EXAMINER	
BOECKMANN, JASON J	
ART UNIT	**PAPER NUMBER**
3752	

MAIL DATE	DELIVERY MODE
12/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/994,860	BLUM ET AL.	
	Examiner	Art Unit	
	JASON J. BOECKMANN	3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 September 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 33-37* is/are pending in the application.

4a) Of the above claim(s) *37* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 33-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/24/2009 7/24/2009 9/3/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is being mailed in response the applicant's phone call on 12/10/2009 and replaces the rescinded office action mailed on 10/13/2009.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/2009 has been entered.

Election/Restrictions

Newly submitted claim 37 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-36, drawn to a method of making or reducing the intensity of a hurricane, classified in class 114.

II. Claim 37, drawn to a submersible, classified in class 114, subclass 312.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the invention of group II does not include the step of maneuvering, staging and positioning the submersibles in a hurricane inception area as claimed in the invention of group I.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 37 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 and 33-36 are rejected under 35 U.S.C. 101 because the disclosed invention is wholly inoperative and therefore lacking credible utility. What has been disclosed is a concept more in the realm of speculation and conjecture rather than the reduction of an idea to a practical application based on science and technology.

Regarding claim 1, applicant claims a method of making a reduced intensity hurricane by positioning a plurality of submersibles in a hurricane interception area; maneuvering the submersibles to a predetermined depth and releasing a gas during a predetermined amount of time, the gas forming bubbles which rise in plume toward a surface to cool the surface of the ocean, thereby reducing the intensity of the hurricane. In order for an invention or process to have credible utility, the applicant's disclosure must contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe the asserted utility. In this case, the application does not contain sufficient information to permit a person of ordinary skill in the art to believe that the process disclosed either could be implemented or could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting. For example, taking into consideration the enormous size of a hurricane, the process of modifying a hurricane disclosed by applicant would take more than the resources realistically available to mankind.

On the issue of compliance with the utility requirement of 35 U.S.C. 101, the following statement made by the Supreme Court of the United State is on point:

> "This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something "useful", or that we are blind to the prospect that what now seems without "use" may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its

successful conclusion. "[A] patent system must be related to the world of commerce rather than to the realm of philosophy".

See, Brenner v. Manson, 148 USPQ 689, 696 (US SupCt 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 and 33-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected to make and/or use the invention.

Since the asserted utility is not credible for the reason set forth above, one skilled in the art would not know how to make and use the claimed invention. For example, in claim 1, the assertion that reducing the hurricane intensity by using the submersibles to release a gas to form a plume to cool the surface of the ocean and thereby, to reduce the intensity of the hurricane, is not feasibly supported by the specification in exact terms (i.e. the grand scale or vast area of the release site, the amount of gas that is required to affect the hurricane, the number of submersibles required for the process, etc.).

Furthermore, the standard for enablement is whether a person skilled in the art would have sufficient information from the application disclosure to make and use the

claimed invention without undue experimentation. In this case, the amount of experimentation necessary to perform the process disclosed would be undue. Undue experimentation would be necessary because:

- The claimed invention is broad and sweeping in scope.
- The nature of the invention is a large-scale environment change.
- The level of one ordinary skill in the art is best characterized as that of a theoretical scientist dealing in probabilities and possibilities rather than that of an engineer dealing in practical applications of technology.
- The outcome of the disclosed concept is entirely unpredictable.
- The application is devoid of working examples.
- The quantity of experimentation needed to use the invention based on the content of the disclosure can only be characterized as astronomical considering the lack of background information, past experiment, and specific detail.

Response to Arguments

Applicant's arguments filed 9/3/2009 have been fully considered but they are not persuasive.

Regarding the applicant's arguments concerning the 35 U.S.C. 101 and 112 1st paragraph rejections, the applicant uses various prior U.S. applications and U.S. patents to support and justify that the present invention meets the requirements of 35

U.S.C. 101 and 112 1st paragraph. However, the examiner is not at liberty to comment on the previous work of other examiners or the Patent office as a whole.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON J. BOECKMANN whose telephone number is (571)272-2708. The examiner can normally be reached on 8:00- 5:00, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. J. B./
Examiner, Art Unit 3752
12/11/2009
/Len Tran/
Supervisory Patent Examiner, Art Unit 3752